

### **REMARKS**

Claims 1-14 and 16-43 are pending in the application, with claims 1, 16, 27, and 33 being the only independent claims. In this amendment, the independent claims have been modified such that the step of “identifying” and been changed to “generating a data set”. One example of a generated data set may be found at page 6, lines 13-14, of the specification which states that “[t]he client may also be provided with a printout such as a booklet 20 ...”. Other examples of a “data set” may be found throughout the specification.

#### **Rejection Pursuant to Section 101**

Claims 1-14 and 16-43 were rejected pursuant to 35 U.S.C. 101. Applicant continues to disagree with the Examiner as to the appropriateness of this rejection and, accordingly, incorporates its prior arguments concerning the Section 101 rejection into these remarks. However, in addition to Applicant’s prior arguments, Applicant notes that the independent claims have been amended to include the step of “generating a data set”. The generated data set represents a clear tangible step in conformance with Section 101. Therefore, Applicant requests that the rejection under Section 101 now be withdrawn.

#### **Rejection Pursuant to Section 103**

Claims 1, 5, 6, 8-10, 12-14, 16, 18-21, 24-30, 33, 35-37, 39 and 41-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,311,293 to MacFarlane in view of U.S. Patent No. 4,561,850 to Fabbri et al. Applicant traverses this rejection for the reason that MacFarlane teaches away from Fabbri et al. and, accordingly, may not be combined with Fabbri et al.

A *prima facie* case of obviousness may ... be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. See M.P.E.P. 2144.5 at 141 (*citing In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)). Further, "[a] prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness...". See M.P.E.P. 2145 at 161. On this point, the controlling case of *In re Gurley*, 31 USPQ2d 1130 (Fed. Cir. 1994), is particularly instructive:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966) ("known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness"); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), cert. denied, 469 U.S. 851 (1984); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (CCPA 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant).

*In re Gurley*, 31 USPQ2d at 1131-32 (*emphasis added*).

A further detail that should be emphasized is that "[i]t is improper to combine references where the references teach away from their combination." See M.P.E.P. 2145 at 161 (*citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

MacFarlane discussed a method and instruments for use in a color selection system in which a person's skin color is the exclusive determinative factor for color compatibility. Specifically, the invention in MacFarlane "relates to a method and instrument for identifying

categories of skin colorations for compatibility with colors of clothing ...”. See Col. 1, lines 18-22. Before discussing the invention, MacFarlane teaches, by way of background, that when determining personal color categories others have “*wrongly* relied upon eye color, color of hair and even racial background”. See Col. 1, lines 30-32 (*emphasis added*). Therefore, MacFarlane states that one must instead use “skin color *exclusively* as the determinative factor ...”. Col. 2, lines 29-31 (*emphasis added*).

The Examiner has cited to MacFarlane as teaching much of the claimed invention, but concedes that it “does not expressly disclose physical characteristic data for at least two physical characteristics for the individual.” The Examiner then relied upon Fabbri et al. as showing “this feature to be old in the fashion art” since “Fabbri teaches two characteristics selected from skin tone and the color of the user’s eyes.” See Office Action of April 10, 2006 at 5. Applicant, however, disagrees with the combination of MacFarlane and Fabbri et al.

MacFarlane teaches, for example, that others have *wrongly* relied on eye color in making color determinations. Yet, it is Fabbri et al.’s use of eye color as a secondary factor that the Examiner has relied upon to support the instant rejection. MacFarlane also teaches away from the use of eye color (or any secondary factor) by stating that skin color is the exclusive determining factor in making a color determination. This identification of skin color as the one and only factor to be used in making a color determination would unquestionably lead those of skill in the art in a direction divergent from the path that was taken by Applicant (i.e. the use of at least two characteristics). As a result, both the M.P.E.P. and the controlling case law strongly support a conclusion that it is improper to combine MacFarlane (which teaches away from the use of

multiple characteristics) with Fabbri et al. (which the Examiner has relied upon as teaching the use of multiple characteristics).

Applicant also respectfully disagrees with the Examiner's position that a combination of MacFarlane and Fabbri et al. would not render a dysfunctional invention since "[t]he invention can still be used for its intend purpose, determining color choices based upon skin tone characteristics. The additional features incorporated by use of the Fabbri et al. system merely allow for the finer determination being made for complimentary and contrasting colors." See Office Action at 6. The problem with this argument is that MacFarlane has excluded the use of any means other than skin tone for making a color determination. Indeed, the use of a secondary factor would require one of skill in the art to read the term "exclusive" out of MacFarlane; something that may not be done. Therefore, not only would one of skill in the art not look to combine MacFarlane with Fabbri et al., the combination of those references would yield a dysfunctional invention since MacFarlane on its face simply does not allow for the use of secondary factors (such as eye color) in making a color determination.

In view of these remarks, Applicant submits that claims 1, 5, 6, 8-10, 12-14, 16, 18-21, 24-30, 33, 35-37, 39 and 41-43 are properly allowable of the prior art. Applicant also submits that all remaining claims are also allowable as they depend from an allowable independent claim. Applicant, however, reserves the right to submit additional arguments as to the allowability of all the outstanding claims in the event the Examiner again rejects the one or more of them.

Applicant submits that the application is now in proper form for allowance. Such action is respectfully requested.

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Respectfully submitted,

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